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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,542	02/14/2005	Hsien-Kun Chu	LC-479/PCT/US	1405

7590 09/15/2006

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EXAMINER

ZIMMER, MARC S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/524,542

Applicant(s)

CHU, HSIEN-KUN

Examiner

Marc S. Zimmer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 10 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/14/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-6, 8, 11-12, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Scheim et al., U.S. patent # 6,018,011. Scheim discloses a method of making polyorganosiloxanes that adhere to formula III in column 3 that entails reacting a polysiloxane diol, formula V, with a silane adhering to formula IV, at least one of which anticipates the structure of claimed compound I (see the bottom structure in column 5). Concerning claims 11 and 12, similar curing catalysts are mentioned in column 7, lines 40-45.

The limitations of claim 17 and 18 are believed to be inherently satisfied by the product/composition taught by Scheim given that they are similarly constituted. "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See also *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established."

Claims 1-4, 7-9, 11-12, 14, and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lien et al., U.S. Patent # 4,528,081. Lien teaches the preparation of acryl-functional polysiloxane by reacting silanol-terminated polydiorganosiloxane (formula 2) with a silane mirroring Applicant's formula 1 where R⁵ is methylene, in the presence tetraisopropyl titanate (column 2, line 54). Also included in the polymer-forming composition are one or more of various photosensitizers outlined in column 3, lines 5-16.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-9, 11-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al., U.S. patent \$ 5,371,116. Sakamoto discloses a curable composition comprising all of the materials outlined in column 3. Exemplary of the acrylic-functional silane is (meth)acrylomethyl monomethyl- and dimethyl di/monomethoxysilane and (meth)acrylopropyltrimethoxysilane. (Meth)acrylomethyltrimethoxysilane is another obvious embodiment in view of formula (2) and the disclosure of its close homologues. Given that there are available both hydrolyzable moieties, silanol groups at the terminals of the polymer, and acryl groups, the composition is both condensation- and photocurable. Favored permutations of the

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photoinitiator are contemplated at the bottom of column 7 and include at least some of those recited in claim 13.

Allowable Subject Matter

Claims 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 15 recites a rather precise ratio of alkoxy groups contributed by the silane to silanol groups contributed by the polymer. The references do not expressly disclose this ratio but, rather, teach an overall amount of silane that is added to a specified amount of the siloxane polymer. Although these references appear to disclose amounts that would furnish a range of ratios of alkoxy group to silanol group that would encompass the range disclosed, it is the Examiner's opinion that the ratio recited by the claim, which is not even a range but a precise figure, is not disclosed with sufficient specificity to have even been rendered obvious by the claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 11, 2006


MARC S. ZIMMER
PRIMARY EXAMINER